

TFM 1625

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

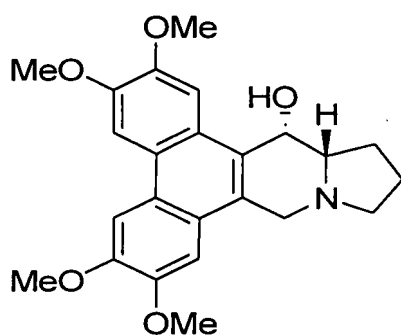
APPLICANT : Baker, et al.
U.S. APPLICATION NO. : 10/502,074
FILING DATE : August 19, 2004
TITLE : Novel Tyloindicines and Related Processes, Pharmaceutical Compositions and
GROUP ART UNIT : 1625
EXAMINER : Amelia Owens

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Response to Restriction Requirement

In response to the Examiner's office action dated March 30, 2007, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group IV, claims 1, 3-11, 17, 26-28 and 55-58 (in-part) drawn to compounds where $n = 1$ and B/C form a ring. In the alternative, at the request of Applicant and in the interest of an efficient examination of this application, Applicants respectfully request the Examiner to give consideration to examining all of the pending claims of the instant application, namely claims 1-11, 17, 26-28, 30, 32-36, 38-42, 45-46, 48-52 and 55-58 together for purposes of expediting prosecution of the present application. Alternatively, Applicants request the Examiner to consider examining the invention of Group IV, claims 1, 3-11, 17, 26-28 and 55-58 (in-part) drawn to compounds where $n = 1$ and 2 and B/C form a ring. Although the invention of groups I-VIII are considered patentably distinct, it is respectfully submitted that the invention groups are sufficiently closely related that they may be examined together with a significant degree of administrative efficiency.

In addition, Applicants elect a species which is represented by the following chemical structure:



Claims 1, 6, 8 and 26-28 are readable thereon. The Examiner is requested to consider additional species according to claim 1 wherein one or more methoxy groups above is substituted by a H, OH, SH, NH₂, O-(C₁-C₄) alkyl, S-(C₁-C₄) alkyl or NH-(C₁-C₄) alkyl group and wherein the OH is represented by R⁵ as originally claimed in claim 1. It is respectfully submitted that this sub-genus is sufficiently narrow to allow the Examiner to examine the application with a great degree of administrative efficiency and provide Applicants with an initial broader scope of examination.

Notwithstanding Applicants' election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicant respectfully requests the Examiner reconsider her restriction requirement. Applicant respectfully submits that prosecution of all of the originally filed claims should not be restricted to the elected invention, for the reasons which are set forth hereinbelow.

According to MPEP §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of all of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct compounds, compositions or methods having a common utility.

Although the claimed invention groups are generally patentably distinct from each other, Applicant respectfully submits that any search the Examiner would need to conduct in examining the instant application and the examination itself would not be unduly burdensome. Moreover, the

examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in MPEP § 803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement in its entirety.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way. No fee is due for the presentation of this response. If any additional fee is due or any overpayment has been made, please debit or credit Deposit Account 04-0838.

Respectfully submitted,

COLEMAN SUDOL SAPONE, P.C.

By: 

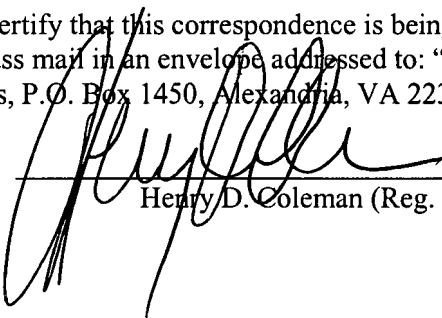
Henry D. Coleman
Reg. No. 32,559

Dated: April 27, 2007

714 Colorado Avenue
Bridgeport, CT 06605-1601
203-366-3560

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on April 27, 2007.


Henry D. Coleman (Reg. No. 32,559)